

REMARKS

The Office Action mailed June 24, 2004, has been reviewed and carefully considered. Claims 1-12 and 14-18 remain pending in this application, with claims 1, 2, 11 and 18 being the only independent claim.

Claims 1-3, 8-11, 16 and 17 have been amended.

Claim 13 has been cancelled.

Claim 18 has been added. No new matter has been added. Reconsideration of the above-identified application, as amended, and in view of the following remarks is respectfully requested.

In the outstanding Office Action, the Examiner objected to the specification because of failure to provide subject headings before each section. Applicants have added subject headings.

Withdrawal of the objection in view of the amendments to the specification is requested.

Rejections under 35 USC § 102

In the outstanding Office Action the Examiner rejected claims 1-3, 8, 10-11, and 13 as being anticipated under 35 U.S.C. §102(b) over U.S. Patent No. 5,250,336 of Greuse.

It is respectfully submitted that the Greuse reference does not anticipate applicants claimed invention. Anticipation requires identity of invention. *See MPEP 2131. See also Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claims. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Greuse's disclosure is directed to the manufacture of labels using a colored backing material of a release liner for pressure sensitive laminates. The reason for coloring the backing material is so that the release characteristic is not significantly changed and without providing migration of the colorant into the pressure sensitive adhesive (Col. 1, lines 62- 68 and Col. 2, lines 1-2). More specifically, Greuse enumerated several advantages concerning the use of the colorant, which is

- being able to discriminate imperfect cuts of white patterns (Col. 2, lines 17-20),
- making weeding operations easier (Col. 2, lines 21-23),
- making weeding by visual means (Col. 2, lines 24-25), enhance visual detections (Col. 2, lines 26-28),
 - provide an inexpensive colorant (Col. 2, lines 29-30),
 - avoidance of migration into the adhesive layer (Col. 2, lines 31-33),
 - providing different effects (Col. 2, lines 31-36), show defects (Col. 2, lines 37-39),
 - avoiding die stains (Col. 2, lines 40-44),
 - visualizing gel particles, adhesive defects or irregularities (Col. 2, lines 45-47),
 - providing for different color variations (Col. 2, lines 48-53) and, lastly,
 - providing a solventless system (Col. 2, lines 54-55).

As Greuse stated, these objectives are obtained by utilizing a release layer which is colored with carbon-black colorant. No other colorant is disclosed. Greuse specifically points out the advantageous characteristics of carbon-black for the label making process outlined in the specification and claimed in his claims. See, for example, Col. 5, lines 36 et seq., Example 2 in Col. 6, lines 34 and 59 enumerates carbon-black colorant. See also Col. 7, lines 65, Col. 8, lines 6, both independent claims, Claim 1 and Claim 5 require carbon black colorant.

Applicants in contrast to Greuse describe and claim the punched shaped parts made of adhesive tape material used for adhering electronic component parts or seals in mobile phones. These adhesive parts are punched by a punching dies which, as is described in applicants specification on page 2, is subjected to severe abrasion, leading to frequent and costly reworking and exchanges of the pouching dies. Applicants specifically mentioned that carbon-black colorant is not suitable for applicants' application, because it also changes the conductivity of the web material which is not acceptable in a production recognition system (see Specification page 2, first paragraph). Accordingly, applicants has found that a non-carbon black colored polymer backing sheet in the claimed system provides a remedy from constant break down of the punching dies and for guiding the backing sheet during the punching process by optical recognition.

All of the presently presented claims include the limitation of non-carbon black colorant and instead using a non-abrasive colorant embedded in the backing material.

Accordingly, applicants' invention claims are distinguishable over the Greuse reference and it is respectfully submitted that the Examiner withdraw his rejection.

Rejections under 35 USC § 103

The Examiner rejected claims 4-7, 9, 12 and 14-17 and as being obvious under 35 U.S.C. §103(a) over U.S. Patent No. 5,250,336 (Greuse) in view of Higgins (U.S. Patent 5,932,352). As pointed out above, Applicants can clearly distinguish their claims from Greuse by claiming a non-carbon black colorant. Higgins does not cure the deficiencies in the Greuse reference and thus, the combination does not make the claims obvious.

In order to properly combine prior art references to demonstrate obviousness of an invention, there must be some teaching, suggestion or incentive to make such a combination. As the Court of Appeals for the Federal Circuit has held:

"It is insufficient that the prior art disclosed the components of the potential device, either separately or used in other combinations; there must be some teaching, suggestion or incentive to make the combination made by the invention."

Northern Telecom Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321, 1323 (Fed. Cir. 1990); In Re Bond, 910 F.2d 831, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). In combining references, the Examiner cannot "simply pick and choose among the elements of assorted" prior art disclosures; rather there must be some teaching or suggestion in the references to suggest the use in the particular claimed combination. Smith Kline Diagnostics, Inc. v. Helena Labs. Corp., 958 F.2d 878, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988). See also, In re Fine, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 311 (Fed. Cir. 1983).

Therefore, the rejection of claims 4-7 9, 12 and 14-17 over the combination of Higgins and Greuse in view of applicants' amended claims is not proper. Therefore applicants respectfully request the withdrawal of this rejection.

Conclusion

For the foregoing reasons applicants submit that independent claims 1, 2, 11 and 18 are patentable over the prior art cited by the Examiner. Applicants also like to mention that new

claim 18 merely claims the alternative element previously provided in claim 1 as a separate claim. Applicants also submit that no reference discloses or suggest any protection from changes in the electrical conductivity of the backing sheet when using the claimed colored polymer.

Accordingly, the claims as presently presented are patentable over the art of record. Claims 3, 10, 12, 14-17 depend from independent claims and thus are patentable for the same reasons that claims 1, 2, 11 and 18 are patentable. Applicants submit that the application is now in condition for allowance and passage to issuance is requested.

If any additional fees or charges are required at this time in connection with the application, authorization is hereby given to charge our Patent and Trademark Office Deposit Account No. 14-1263.

CHANGE OF ADDRESS:

Please note that the applicants' attorneys New York office has moved to a new address as stated below. Fax and Phone number remain the same.

Respectfully submitted,

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